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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,359	03/09/2000	Wadood Hamad	A-6756	3106
1726	7590	09/05/2006	EXAMINER	
INTERNATIONAL PAPER COMPANY 6285 TRI-RIDGE BOULEVARD LOVELAND, OH 45140			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/522,359

**Applicant(s)**

HAMAD ET AL.

**Examiner**

Lawrence D. Ferguson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 8, 18, 20-29 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 8, 18, 20-27, 29 and 32-38 is/are rejected.
- 7) ☒ Claim(s) 4 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment mailed June 9, 2006.

Claims 1, 4, 18 and 28 were amended, claim 19 was cancelled and claims 37-38 were added, rendering claims 1-4, 6, 8 and 18 and 20-38 pending in this case.

### ***Claim Rejections – 35 USC § 102(b)***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6, 8, 20-27, 29 and 31-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawson (U.S. 4,161,422).

Lawson discloses an impregnated paper comprising thermosetting resin (column 1, lines 21-22) having a pattern of impregnated zones in the form of discontinuous areas of any desired geometrical shape or configuration, such as circles, stripes, or regular or irregular polygons or complex designs which convey information such as words or pictures (printing) (column 3, lines 39-62). Additionally, printing paper is not clearly defined over that of filter paper, and is therefore given little patentable weight. Lawson

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further discloses the paper has a polyester or acrylic composition (column 3, lines 11-38). Regarding claims 37-38, calendering is directed to a process, which introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

***Claim Rejections – 35 USC § 103(a)***

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawson (U.S. 4,161,422) in view of Eber et al (U.S. 4,488,932).

Lawson is relied upon for claim 1 as above. Lawson does not explicitly disclose styrene butadiene in the paper structure. Eber teaches paper made of pulp having a geometric component which comprises styrene butadiene (column 15, line 42 through column 16, line 10). Lawson and Eber are both directed to paper compositions. It would have been obvious to one of ordinary skill in the art to have employed the styrene butadiene, as taught in Eber, in the paper of Lawson to improve the tensile strength of the paper (column 15, lines 42-68). Since Lawson teaches that resins may be of any desirable thermoplastic or thermoset resins capable of acting as a binder (column 3, lines 14-20), and Eber also teaches specific bonding agents or binders including styrene butadiene, it would have been obvious to one of ordinary skill in the art to have used styrene butadiene as a binder in the filter paper of Lawson. It is also noted that there is

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a commonality with resins such as polyvinyl acetate, and polyvinyl chloride and urea formaldehydes, to name a few. Therefore the styrene butadiene disclosed by Eber is deemed to be a functional equivalent of the binder's disclosed by Lawson for purposes of binding fibers.

5. Claims 4 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art does not teach or suggest the recited crack resistant printing paper further including wherein the polymer is no more than 5% of the basis weight of the paper or board. The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

### ***Response to Arguments***

6. Applicant's argument to rejection made under 35 U.S.C. 102(b) as being anticipated by Lawson (U.S. 4,161,422) have been considered but are unpersuasive. Applicant argues filter paper is different from printing paper and Lawson does not disclose printing paper. Examiner respectfully disagrees because Lawson discloses an impregnated paper comprising thermosetting resin (column 1, lines 21-22) having a pattern of impregnated zones in the form of discontinuous areas of any desired geometrical shape or configuration, such as circles, stripes, or regular or irregular polygons or complex designs which convey information such as words or pictures

(printing) (column 3, lines 39-62). Additionally, although Applicant has provided definitions for filter paper and printing paper, applicant has not convincingly argued or provided evidence to the contrary to demonstrate that filter paper and printing paper are materially different. Applicant has not argued or shown that filter paper is not printable. There is not a clearly claimed distinction. Therefore, the printing paper is given little patentable weight. Applicant further argues the reference does not disclose a polymer material which is no more than 5% of the basis weight of the paper, which resulted in rejection over claims 4 and 28.

Rejection made under 35 U.S.C. 103(a) as being unpatentable over Lawson (U.S. 4,161,422) has been withdrawn due to Applicant amending claims 4 and 28 to include wherein the polymer is no more than 5% of the basis weight of the paper or board.

Applicant's argument to rejection made under 35 U.S.C. 103(a) as being unpatentable over Lawson (U.S. 4,161,422) in view of Eber et al (U.S. 4,488,932) have been considered but are unpersuasive. Because Lawson is maintained over instant claims 1-3, 6, 8, 20-27, 29 and 31-36 and Applicant has not presented any showing as to why the claims are not obvious under Lawson in view of Eber, the rejection is maintained for reasons of record.

Applicant's argument to rejection made under 35 U.S.C. 103(a) as being unpatentable over Lawson (U.S. 4,161,422) in view of Mitchell et al (U.S. 6,010,595) is withdrawn due to amendments made by Applicant.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson  
Patent Examiner  
AU 1774



RENA DYE  
SUPERVISORY PATENT EXAMINER

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